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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,584	06/09/2000	Peter T Dietz	55434USA1A.002	2946

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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/21/2001

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,584

Applicant(s)

DIETZ, PETER T

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether a flexible polymeric material within the claim being a non-adhesive or an adhesive polymer.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver et al (US 4,797,317). Oliver discloses a solar control window film mounted on a vehicle window having a layered structure as follows, a scratch-resistant coating, an oriented polyethylene terephthalate (PET), an acrylic adhesive layer, a vignette layer, an oriented PET, an acrylic adhesive as shown in figure 1. With regard to claims 7 and 8, Oliver is silent as to a test which a glazing element of the laminate passes and modulus strength of the adhesive. However, since the laminate of Oliver is structurally the same, and made of the same materials as the presently claimed composite. It is the examiner's position that the glazing element of the laminate of

Oliver would inherently pass a test as claimed and the adhesive would inherently possess the same modulus strength as that of the present invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver et al (US 4,797,317). Oliver does not specially disclose the thickness of the lamina. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the thickness range of the lamina since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In *re Aller*, 105 USPQ 233. It would have been obvious to the skilled artisan to have optimized thickness range of the laminate, motivated by the desire to obtain a solar control film for retrofit improvement of motor vehicle window.
7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver et al (US 4,797,317) as applied to claim 1 above, and further in view of Bilkadi et al (US 5,677,050). Oliver is silent as to a cured ceramer of a hard coating. Bilkadi supplies the missing feature. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included a cured ceramer into a hard

Art Unit: 1771

coating motivated by the desire to obtain a coating that is excellent in abrasion resistance and outdoor durability.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver et al (US 4,797,317) and further in view of Motter et al (US 4,112,171). Figure 2 of Oliver shows the laminate adhered to window glass by means of adhesive layer. Oliver is silent as to a glass structure. Motter discloses a laminated glass structure currently required in automobile windshields and a tempered glass glazing unit commonly employed in the automobile windows in the United State (column 1, lines 30-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a substrate being either tempered or laminated window glass because a laminated glass structure or a tempered glass glazing unit is conventional to glass window art. With regard to claim 11, See inherency rational in paragraph no. 4.
9. Claims 1-3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willdorf (US 4,028, 475) in view of Motter et al (US 4,112,171). Willdorf discloses a security film for shatterproofing windows meeting all the limitations as recited within the claims except a scratch-resistant coating. Oliver or Motter supplies the missing feature. Oliver shows such a coating **11** in figures 1-3. Motter shows such a coating **21** in figures 2-4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a scratch-resistant coating into the laminate motivated by the desire to obtain a security film

Art Unit: 1771

having excellent abrasion surface. With regard to claims 7, 8 and 11, see inherency rational in paragraph no. 4.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willdorf (US 4,028, 475) in view of Motter et al (US 4,112,171), as applied to claim 1, and further in view of Bilkadi et al (US 5,677,050). The combination of Willdorf with the Motter does not teach a cured ceramer. See obviousness rational in paragraph no. 7.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
November 14, 2001



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